

## REMARKS

This is a response to the non-final office action dated 10-5-2007 ("office action").

### HILTON DAVIS / FESTO STATEMENT

In this paper, several claims were amended. These claim amendments were not made for any reason related to patentability. Rather, these changes were implemented to implement various improvements in form, and make explicit what was already inherent to the claim.

Further, these changes were made to perfect the claims for appeal.

### NEW CLAIMS

In this paper, two claims were added. The claims enjoy ample support throughout the application as originally filed. Accordingly, no new matter has been added.

### SUMMARY OF CHIEF ARGUMENTS

The foregoing summary provided in the interest of being helpful, and to present a broad overview of Applicant's arguments. These are given without any intended limitation, and all expanded arguments are stated further below.

1. The art as applied does not teach the claimed operations including, responsive to the user selecting a kept item from the displayed search cart list, a browser navigating to a site associated with the selected item. Rather, Ehrlich's system is aimed at consummating a sales transaction, not navigating to sites. Indeed, Ehrlich teaches away from the claims because the Ehrlich system purportedly "enables the sale consummation directly from the shopping cart without having to visit the merchant's web sites."

2. The art as applied does not show the claimed actions performed by a browser. Rather, Ehrlich's contains little or no disclosure related to a browser, and Ehrlich's work is actually done by a central shopping cart manager 95, shopping cart engine 125, and other components of a virtual shopping cart

system 10 that are sited in a host server 15 centrally located and clearly distinct from any remote shoppers' web browsers. Likewise, Bowen lacks any disclosure of a browser, and fails to mention a browser even once. Rather, Bowen uses a customized software specifically tailed to the specific needs of the healthcare industry.

3. Lacking the browser-performed actions as discussed above, the applied art *a fortiori* fails to teach modifying a browser, e.g., claim 31.

4. The office action has taken the approach of citing Applicant's claims verbatim, and inserting annotations indicating where each claimed limitation is supposed to be found in various references (under the Examiner's interpretation). [Office Action: pages 2-13] The office action did not further explain, justify, or expand on the Examiner's interpretation of how the references allegedly satisfy the claim limitations. In many cases, and as discussed in greater detail below, the office action cites reference passages that seem to be completely unrelated. Thus, the office action states conclusions without providing any arguments. Without more, these un-stated arguments are wholly inadequate. And, in many cases, careful analysis of the references reveals the contrary conclusion- - that there is no basis in the reference for the Examiner's proposed reading.

The U.S. Supreme Court has emphasized that **"rejections on obviousness grounds cannot be sustained by mere conclusory statements;** instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."<sup>1</sup> The Court required that analysis supporting a section 103 rejection should be made explicit.<sup>2</sup> Moreover, this analysis was made equally applicable to the courts and patent examiners.<sup>3</sup> In this regard, the application of prior art in the office action is fatally flawed in a number of respects, as explained in greater detail below.

#### 35 USC 103 REJECTIONS:

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- 1 KSR Int'l v. Teleflex, 127 S. Ct. 1727, 1741 (2007).  
2 Id.  
3 Id. at 1734.

CLAIMS 1-5, 7-12, 14-19, 21-26, 28-32

These claims were rejected under 35 USC 103 as being unpatentable over the combination of U.S. Patent Document 2002/0156685 ("Ehrlich") in view of U.S. Patent Document 6,546,388 ("Edlund") and U.S. Patent Document 20030036927 ("Bowen"). This rejection is respectfully traversed. The claims are patentable since a *prima facie* case of obviousness does not exist, as discussed in greater detail below.<sup>4</sup>

Teaching/Suggestion of Claim LimitationsIntroduction

First, the *prima facie* obviousness case is incomplete because, even if the references were to be combined as suggested, the combination still does not teach or suggest all the claim limitations.<sup>5</sup>

Claim 1

As to claim 1, Ehrlich-Bowen-Edlund do not teach **"the browser adding a selection mechanism to the displayed results list, the selection mechanism programmed to receive user input identifying one or more items of search results to keep from among the displayed results list."** As to this feature, the Examiner applied Bowen, and namely, Bowen's FIG. 5 (ref. 402, 502) and para. 0071.

However, as to reference numerals 402 and 502, these do not have anything to do with search results. Bowen clearly explains that these features are part of Bowen's intricate, healthcare specific, system for entering search criteria. [Bowen: para. 0036, para. 0058] Relatedly, Bowen limits searches to predefined healthcare related search criteria, where the user must select from a list of document types, visits, problems; content definitions, care plans, and healthcare organization. [Bowen: para. 0021, 0041-0051] As to para. 0071, this passage merely discusses the procedure for opening and displaying documents.

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4 MPEP 2142.

5 MPEP 2142, 2143.03.

There is nothing about any mechanism for selecting from a displayed results list.

Applicant notes that Paragraph 0069 mentions the user selecting documents from a displayed list, by checking a box next to the desired documents. However, Bowen fails to give any more detail, and moreover, Bowen specifically admits that this feature is not shown in the drawings. [Bowen: para. 0069] Without more, Bowen fails to provide enough disclosure on this point to enable an ordinarily skilled artisan to practice the claimed feature. In other words, Bowen's disclosure here is nonenabling as to the claimed feature. If the Examiner disagrees, Applicant kindly requests a specific explanation as to why (in the Examiner's reading) the cited passage describes the claimed invention sufficiently to have placed a person of ordinary skill in the field of invention in possession of it, so that Applicant has a full and fair opportunity to address this reasoning on appeal.<sup>6</sup>

Nevertheless, for the sake of argument, Applicant will address Bowen's para. 0069. Bowen's para. 0069 still doesn't show a browser adding the selection mechanism to the search results provided by the search engine. Rather, Bowen's intricate, healthcare-specific software package (called the "record explorer") purportedly displays a window 300 containing a section for defining search criteria and a section for displaying search results. Bowen fails to show that a "browser" adds a selection mechanism to a results list received from a search engine. In this regard, Bowen lacks any disclosure of a browser, and fails to mention a browser even once. Rather, Bowen uses a customized software specifically tailed to the healthcare. [Bowen: Title, Field of Invention, para. 0008, 0021, 0022, Fig. 1] Bowen's customized software is implemented by a record explorer and so-called search engine, presenting a series of health care related search criteria concerning predetermined sub-elements such as document types, visits, problems, content definitions, care plans, healthcare organization, etc. [Bowen: para. 0021] Bowen lacks any discussion of a browser, and accordingly, lacks an operation of "the browser adding a selection mechanism to the displayed search results list..."

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<sup>6</sup> In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

The applied art further lacks claimed features including **"responsive to the browser receiving user input via the selection mechanism, the browser preparing a search cart list containing items of the search results limited to the kept items."** As to this feature, the office action applied Bowen, and namely, Figure 5 (ref. 336) and para. 0071. However, item 336 shows a results list, presumably a list of search results stemming from the user's search criteria. There is no showing that Bowen's results list contains items of search results limited to kept items. As to para. 0071, this section mentions that the record explorer opens and displays the documents one at a time or several at a time. But still, there is nothing related to preparing a search cart list as claimed.

Furthermore, there is nothing in Bowen to show a search cart list "containing items of the search results limited to the kept items" as claimed.

Furthermore, as mentioned above, Bowen's disclosure notoriously fails to disclose anything related to a browser. Therefore, Bowen necessarily fails to show actions responsive to the browser receiving user input via the selection mechanism (as claimed), and further actions such as the browser preparing a search cart list.

The applied art further lacks **"the browser displaying the search cart list and upon user selection of a kept item of search results from the displayed search cart list, navigating to a site associated with selected item directly from the displayed search cart list without the user having to operate the browser to navigate back to the displayed results list and choose the selected item of search results therefrom."** As to this feature, the Examiner applied Ehrlich, and specifically, Ehrlich's Abstract and paragraphs 0002, 0017, and 0027.

First, Ehrlich's own words make it clear that the work of Ehrlich's system is not performed by a browser. In this regard, outside its background and definitions sections, Ehrlich only mentions a "browser" once (in para. 0080), in a context unrelated to the subject claim feature. Indeed, Ehrlich's work is done by a central shopping cart manager 95, shopping cart engine 125, and other components of a virtual shopping cart system 10 that are sited in a host server

15 centrally located and clearly distinct from any web browsers of remote shoppers. [Ehrlich: Fig. 3A, ref. 335, 340; Fig. 1, ref. 15, 35, 37, 39; para. 0065] Moreover, the office action recognized that Ehrlich does not teach a browser receiving a user's query and submitting the query to a search engine. [Office Action: page 7]

Furthermore, regardless of which entity (e.g., a browser) performs the claimed task, the task itself is missing from Ehrlich. There is nothing in Ehrlich that discloses navigating to sites associated with the identified items of search results directly from the cart as claimed. Indeed, the Examiner has already recognized that Ehrlich enables sale consummation directly from the shopping cart without having to visit the merchant's web sites. [Office Action of 4-19-2007: page 14] It is observed that Ehrlich is aimed at automating e-commerce transactions, not web surfing.

Furthermore, Ehrlich's para. 0027, by its own words, distinctly teaches away from the claimed feature. Indeed, Ehrlich says the its invention "enables the sale consummation directly from the shopping cart without having to visit the merchant's web sites." [Ehrlich: para. 0027] Thus, it cannot be said that Ehrlich navigates to a site responsive to user selection of an identified item of search results from the displayed search cart list - - indeed, Ehrlich does the opposite ("... without having to visit the merchant's web sites.") [Ehrlich: para. 0027] Further reference on this point is directed to Ehrlich's para. 0074.

As to the Examiner's citation of paragraph 0002, this is merely Ehrlich's "Field of the Invention," which does discusses its shopping cart model in extremely broad terms, and fails to contribute any enabling teaching applicable to the claimed feature. Paragraph 0002 does not teach the claimed feature.

As to the Examiner's citation of para. 0017, the office action did not specifically explain how this paragraph teaches the claimed features. By its very words, however, this passage addresses the perceived difficulties currently facing shoppers using conventional e-shopping services. Therefore, by virtue of its own criticism, it is clear that Ehrlich's system does not include these features. In other words, by its criticism of these features, Ehrlich is quite clearly teaching

away from the (problem-ridden) conventional approaches.

In view of the foregoing, the features of claim 1 are not taught by the applied art.

### Claim 30

Independent claim 30 is distinguished for the same reasons expressed above, and additionally as follows.

Chiefly, the applied art does not teach an **“enhanced search method operable in an environment where a browser receives a user’s query and submits the query to a search engine, and the browser receives from the search engine a results list of at least one item of search results arising from the query, where each said item is associated with at least one site, and the browser further displays the results list”** as claimed.

The office action did not address this claim language, instead grouping its discussion of claim 30 with the discussion of claim 1. [Office Action: pages 2-3]. The office action did, however, specifically acknowledge that Ehrlich does not teach a browser receiving a user’s query and submitting the query to a search engine. [Office Action: page 3]

Nevertheless, claims 1 and 30 utilize different claim language. Yet, all words in a claim must be considered in judging the patentability of that claim against the prior art.<sup>7</sup> To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.<sup>8</sup>

Without more, the *prima facie* case of obviousness is not complete as to claim 30.

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<sup>7</sup> In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

<sup>8</sup> Ex Parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP 706.02(j).

Claim 31

Claim 31 is patentable for the same reasons expressed above, and for some additional reasons.

The office action argued that Ehrlich teaches a **“method for enhancing operation of a computer-implemented browser...”** including an operation of **“modifying the browser...”** [Office Action: pages 9-10] The office action pointed to Ehrlich's paragraph 0115 in support of this argument. Para. 0115, however, merely contains boilerplate language stating that “numerous modifications may be made... without departing from the spirit...” [Ehrlich: para. 0115] There is nothing in para. 0115 to suggest or support anything, let alone the operation of enhancing a computer-implemented browser. In this sense, Ehrlich's para. 0115 fails to qualify as an enabling 35 USC 103 reference as to the claims. If the Examiner disagrees, Applicant kindly requests specific explanation as to how the cited passage describes the claimed invention sufficiently to have placed a person of ordinary skill in the field of invention in possession of it, so that Applicant can have a full and fair opportunity to address the Examiner's arguments on appeal.<sup>9</sup>

A reference itself must sufficiently describe the claimed invention to have placed the public in possession of it.<sup>10</sup> Even if a claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling.<sup>11</sup> In order to anticipate, a prior art reference must be enabling, thus placing the allegedly disclosed subject matter in the possession of the public.<sup>12</sup> The reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of invention in possession of it.<sup>13</sup>

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<sup>9</sup> In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

<sup>10</sup> Paperless Accounting, Inc. v. Bay Area Rapid Transit System, 231 USPQ 649, 653 (Fed. Cir. 1986). Ex parte Gould, 231 USPQ 421 (CCPA 1973).

<sup>11</sup> Id.

<sup>12</sup> Akzo N.V. v. United States ITC, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986); Ashland Oil, Inc. v. Delta Resins & Refracs., Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); Reading & Bates Constr. Co. v. Baker Energy Res. Corp., 748 F.2d 645, 223 USPQ 1168 (Fed. Cir. 1984)

<sup>13</sup> In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).



Ehrlich's boilerplate language fails to provide any meaningful disclosure pertaining to the claim language, and therefore fails as an enabling 35 USC 103 reference.

Furthermore, a careful reading of the non-boilerplate text in the remainder of Ehrlich reveals that Ehrlich actually teaches away from the claim language. First, Ehrlich's disclosure does not contain any meaningful disclosure related to a browser. In this regard, outside its background and definitions sections, Ehrlich only mentions a "browser" once (in para. 0080), in a context unrelated to the subject claim feature. Indeed, Ehrlich's work is done by a central components such as a shopping cart manager 95, shopping cart engine 125, and other components of a virtual shopping cart system 10; these are sited in a host server 15 centrally located and clearly distinct from any web browsers of remote shoppers. [Ehrlich: Fig. 3A, ref. 335, 340; Fig. 1, ref. 15, 35, 37, 39; para. 0065]

Therefore, as Ehrlich utilizes programming features central to many users instead of the fundamentally different approach of modifying users' web browsers, Ehrlich actually teaches away from a "method for enhancing operation of a computer-implemented browser..." including an operation of "modifying the browser..."

Accordingly, claim 31 is *a fortiori* distinguished from the applied art.

Introduction: Claims 2-5, 7-12, 14, 15-19, 21-26, 28-29

For similar reasons as stated above, independent claims 15 and 29 are absent from the applied art. And, even without considering any individual merits of claims 2-5, 7-12, 14, 16-19, 21-26, and 28, these claims are distinguished from the applied art because they depend from independent claims that are distinguished as discussed above.<sup>14</sup> Nonetheless, certain features of these dependent claims are noted to further distinguish over the applied art.

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<sup>14</sup> If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Claim 3

Taking claim 3 as one example, the applied art fails to show "where the operation of providing a selection mechanism comprises one of: providing a selection mechanism built-in to the browser, providing a selection mechanism that is an add-on to the browser." The office action suggests that this feature is found in Ehrlich's para. 0021. However, this section merely contains incidental use of the term "browser." Applicant does not deny that browsers do exist, and people use them to browse. Still, there is still no meaningful disclosure in Ehrlich relating to the use of a browser to implement a selection mechanism. Furthermore, Ehrlich specifically teaches away from the existing or proposed technological solutions of para. 0021, referring to them as impractical, brute force, or inconvenient. [Ehrlich: para. 0021]

Claim 12

Taking claim 12 as another example, the applied art fails to teach that "said search cart list comprises a temporary queue in which entries are not saved across search sessions." The office action proposes that this is found in Ehrlich's para. 0074. This paragraph suggested that, typically, the shopping cart exists for the duration of the shopper's session with a virtual shopping cart system, and is not stored long term. At first glance, this passage seems to have some pertinence because of the coincidental use of the term "session." However, a more detailed reading of Ehrlich reveals that Ehrlich's "session" is really multiple search sessions. Indeed, Ehrlich's goals include customers being able to browse any store, at any time, and being able to choose an item for the cart and have any information applicable to that potential purchase retained for subsequent purchasing decisions, regardless of when that decision is made. [Ehrlich: para. 0021] Moreover, Ehrlich's examples specifically shows that purchase information is saved across different searches. [Ehrlich: para. 0093-0099] In this particular example, the user conducts different searches for three different items: (1) the book "Professional Active Server Pages 3.0," (2) the book titled "Bee Season," and (3) the toy "Deluxe Start Action Factory." Throughout, there is a single

session ID, namely "123." Ehrlich therefore saves the results of each separate search across searches.

Accordingly, Ehrlich does not teach operations where "said search cart list comprises a temporary queue in which entries are not saved across search sessions" as claimed.

#### Claim 32

Taking claim 32 as another example, the applied art does not disclose that the operation of modifying the browser comprises "downloading a client-side extension comprising one of the following: a plug-in, an XML applet, a Java applet, a JavaScript applet." The office action proposes that this is found in Ehrlich's paragraphs 0013, 0055.

As to para. 0013, this appears in Ehrlich's background section. Of course, the use of patents as references is not limited to what the patentees describe as their own inventions..." To wit, a patentee's description of an invention may be used as a prior art reference, regardless of whether the patentee is describing his own invention (in his detailed description) or whether s/he is describing the invention of another (in his background). However, by citing para. 0013, the office action misapplies this legal precedent. There is absolutely no legal support for the proposition that, using the benefit of hindsight reconstruction, the Examiner can pick and choose aspects of the patentee's invention and the unrelated inventions of others that by chance occur in the patentee's background, and consider their combination to be a "teaching," applied to Applicant's claims.

This situation is better illustrated using a hypothetical example. In a patent, the patentee describes his invention, a turbojet engine. As background to his patent, the patentee describes various early aircraft power schemes including the first ornithopter (a machine that flies by flapping wings), constructed by Gustave Trouvé in 1870. Using the present Examiner's logic, it would be proper to construct a rejection applying the features of the patentee's jet engine and features of Trouvé's ornithopter simply because their description occurred in the

same reference, even though no one (including the patentee) ever conceived of an invention combining such features.

Regardless of its teaching, then, no persuasive justification exists for applying the content of Ehrlich's para. 0017 to Applicant's claims.

As to the application of para. 0055 to claim 32, this passage arises from Ehrlich's general definitions, and reads as follows: "Schema: A set of grammatical rules that define the allowed structure and syntax of a document. DTD is a specific type of schema, which is used to define XML languages." This passage seems to be completely unrelated, and the Examiner has not provided any argument or explanation as to why this applies to claim 32. The Examiner is reminded that the U.S. Supreme Court has emphasized that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."<sup>15</sup> In this regard, the office action has not satisfied its *prima facie* case as to claim 32 and para. 0055.

### Reason to Combine

#### Introduction

In addition to the reasons given above, the *prima facie* obviousness case is also defective because there has been no adequate showing of a reason that would have prompted an ordinarily skilled artisan to combine the elements in the way the claimed invention does.<sup>16</sup> The Supreme Court has recognized that a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.<sup>17</sup> The Supreme Court also recognized that, in this regard, helpful insight is available by considering whether there is any suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of

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<sup>15</sup> KSR Int'l.v. Teleflex, 127 S. Ct. 1727, 1741 (2007).

<sup>16</sup> Id.

<sup>17</sup> Id.

ordinary skill in the art, to modify the reference or to combine reference teachings.<sup>18</sup> Furthermore, the Patent Office has acknowledged that, in formulating a rejection under section 103 based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.<sup>19</sup>

Analysis: Adding Bowen to Ehrlich

The office action proposed adding Bowen's features ("refs. 402, 502; and 336 of Fig. 5, and para. 0071") to Ehrlich because this would purportedly: "...enable the search method" because "In the filtered view (not shown in the figures), the record explorer displays in one view the selected documents and objects in date/time order according to a user preference as to descending or ascending order. In the filtered view the documents are concatenated or stepped one in front or behind the others with the title bar showing for each document window. Additional sorts may be made by date, department or type of document.."

For a number of reasons, the Examiner's argument for combining references is unpersuasive.

**1. First, the Examiner's explanation of why would be obvious to combine Bowen and Ehrlich is unintelligible.** The Examiner's explanation, appearing on pages 4-5, is organized in a single sentence of 173 words that reads in the following format: "It would have been obvious... to have modified Ehrlich by the teaching of Bowen because [*citation from Applicant's claims*] would enable the search method because [*quote from Bowen*]." Other than repeating Applicant's claims and quoting Bowen, only the Examiner's words "would enable the search method" help provide some explanation as to why the

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<sup>18</sup> Id.

<sup>19</sup> USPTO memo from Margaret A. Focarino, Deputy Commissioner for Patent Operations, dated May 3, 2007.

combination would allegedly be obvious. Applicant is unable to understand to understand the intended meaning, and kindly requests a restatement of the Examiner's reasoning in plain English.

**2. Second, as to each cited feature of Bowen whose incorporation into Ehrlich is suggested, there are compelling reasons why the combination is improper. These are explained as follows:**

A. Ref. 402 & 502, Fig. 5. As explained by Bowen, these components are part of Bowen's intricate, healthcare specific, system for selecting search criteria from a predefined list. [Bowen: para. 0036, para. 0058] There would not be any reason to incorporate this feature into Ehrlich because Ehrlich already contemplates the user's search for a particular item. [Ehrlich: para. 0071] Some specific searches are discussed in para. 0091-0099. Ehrlich also demonstrates awareness of other search technology in para. 0003-0022. There would be no reason to add the cited features of Bowen, since they duplicate what Ehrlich already has.

B. Para. 0071. As explained by Bowen, this concerns the record explorer opening and displaying documents (one at a time, or several at a time.) However, Ehrlich already contemplates operations where the comparison shopping engine 125 returns search results to the shopper 80 through the web application server 85. At this time, the user views a display of the search results. The shopper is then able to select an item from the results presented by the web application server 85 and "add" the item to a virtual shopping cart. [Ehrlich: para. 0072-0073] Hence, there does not appear to be any reason to incorporate Bowen's document display into Ehrlich, because Ehrlich already contemplates a means to select items from the search results for purchase.

D. Ref. 336, Fig. 5. As explained by Bowen, this concerns a results list, which is a list of documents responsive to the search performed by the search engine. [Bowen: para. 0067] The search results

are displayed in the area 336 responsive to the output from the search engine to permit the user to review the search results. [Bowen: para. 0071] However, as discussed above, Ehrlich already contemplates operations where the comparison shopping engine 125 returns search results to the shopper 80 through the web application server 85. Moreover, Ehrlich mentions selecting an item to purchase from search results. [Ehrlich: para. 0095-0099] Consequently, there is no reason to incorporate the results list of Bowen into Ehrlich, since Ehrlich already has such a features.

Analysis: Adding Edlund to Ehrlich

The office action proposed adding Edlund's feature ("coupling to a search engine a graphical user interface for accepting keyword search terms..." from Edlund's Abstract) to Ehrlich for the following reason: to enable Ehrlich to conduct the following activity ("presenting to an end-user the intermediate matching search results of a keyword search in an index list of information...." from Edlund's Abstract). [Office Action: page 3]

The argument for combining the references is unpersuasive for a number of reasons.

**1. First, the proposed Ehrlich-Edlund combination is improper because the references teach away from this combination.** Ehrlich's disclosure distances itself from previous approaches (such as Edlund's) that use mere search engines, characterizing them as inaccurate, inconvenient, and difficult. [Ehrlich: para. 0016-0017] Ehrlich suggests that the state of the art does not adequately address shoppers' needs. [Ehrlich: para. 0020]

In this regard, Ehrlich proposes that customers should be able to browse any store, at any time, and be able to choose an item for a virtual shopping cart *and have any information available to that potential purchase retained for subsequent purchasing decisions*. [Ehrlich: para. 0021] Ehrlich proposes this "regardless of which shop or mall" that shoppers visit on the worldwide web.

[Ehrlich: para. 0021] Along these lines, Ehrlich further teaches away from the "brute force" solution of opening multiple instances of a browser and establishing connections between the client and multiple web sites. [Ehrlich: para. 0021] Hence, Ehrlich suggests using a web application server to handle requests from clients. [Ehrlich: para. 0030] Accordingly, Ehrlich teaches away from search engine approaches.

A prior art reference must be considered in its entirety (as a whole), including portions that would lead away from the claimed invention.<sup>20</sup> Furthermore, it is improper to combine references where the references teach away from their combination.<sup>21</sup>

As Ehrlich teaches away from the proposed Ehrlich-Edlund combination, the reason for an ordinarily skilled artisan to make this combination is lacking.

**2. Second, the proposed Ehrlich-Edlund combination is improper because it would change Ehrlich's principle of operation.**<sup>22</sup> As discussed above, Ehrlich distances itself from prior approaches that use mere search engines. It is no surprise that, in subsequent paragraphs, Ehrlich's disclosure of its own invention proposes an entirely different structure than a simple search engine. Indeed, Ehrlich employs a central shopping cart manager 95, shopping cart engine 125, and other components of a virtual shopping cart system 10 that are sited in a host server 15 centrally located and clearly distinct from any web browsers of remote shoppers. [Ehrlich: Fig. 3A, ref. 335, 340; Fig. 1, ref. 15, 35, 37, 39; para. 0065] Modifying Ehrlich to use Edlund's search engine approach would completely change the Ehrlich's principle of operation, requiring a substantial redesign and reconstruction of Ehrlich's elements.<sup>23</sup>

For these reasons, the *prima facie* case of obviousness is incomplete and

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<sup>20</sup> W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). MPEP 2141.02

<sup>21</sup> In re Graselli, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983). MPEP 2145(4).

<sup>22</sup> In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01.

<sup>23</sup> MPEP 2143.01.



claim 1 is patentable.

3. **Third, in the absence of hindsight reconstruction, the rationale for combining Ehrlich with Edlund does not make sense.** The office action proposed adding Edlund's feature ("coupling to a search engine a graphical user interface for accepting keyword search terms...") to Ehrlich. [Office Action: page 3] The rationale was to enable Ehrlich to "[present] to an end-user the intermediate matching search results of a keyword search in an index list of information...." [Office Action: page 3] Nevertheless, the end product still does not explain why it would benefit Ehrlich to present to an end-user the intermediate matching search results of a keyword search. There has been no reasoning, in plain English, of any tangible benefit. Further, the proposed benefit itself (Edlund's "intermediate matching search results") is vague, since Edlund only mentions it twice—in the Abstract and Summary. Edlund's specification or drawings contain no meaningful disclosure of this term.

Rather, it seems the office action has cherry-picked features from Edlund's Abstract for addition to Ehrlich, in order to compensate for shortcoming in Ehrlich's disclosure. With nothing more, the Ehrlich-Edlund combination is merely the result of hindsight reconstruction.

However, it is improper to attempt to establish obviousness by using the applicant's specification as a guide to combining different prior art references to achieve the results of the claimed invention.<sup>24</sup> The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure.<sup>25</sup> The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.<sup>26</sup> Obviousness is tested by "what the combined

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<sup>24</sup> Orthopedic Equipment Co., Inc. v. United States, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983).

<sup>25</sup> In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

<sup>26</sup> In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered

teachings of the references would have suggested to those of ordinary skill in the art."<sup>27</sup> But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination."<sup>28</sup> And "teachings of references can be combined only if there is some suggestion of incentive to do so."<sup>29</sup>

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."<sup>30</sup> It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made. . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art."<sup>31</sup>

The policy of the Patent and Trademark Office<sup>32</sup> is to follow in each and every case the standard of patentability enunciated by the Supreme Court in *Graham v. John Deere Co.*<sup>33</sup> As stated by the Supreme Court:

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obvious."); *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (nothing of record plainly indicated that it would have been obvious to combine previously separate lithography steps into one process). See e.g., *In re Gordon et al.*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (mere fact that prior art could be modified by turning apparatus upside down does not make modification obvious unless prior art suggests desirability of modification); *Ex Parte Kaiser*, 194 USPQ 47, 48 (Pat. Bd. of App. 1975) (Examiner's failure to indicate anywhere in the record his reason for finding alteration of reference to be obvious militates against rejection).

27 *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

28 *ACS Hosp. Sys. Inc. v. Montefiore Hosp.*, 32 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

29 *Id.*

30 *W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

31 *Id.*

32 MPEP 2141.

33 148 USPQ 459 (1966).

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.<sup>34</sup>

Thus, hindsight reconstruction, using the applicant's specification itself as a guide, is improper because it fails to consider the subject matter of the invention "as a whole" and fails to consider the invention as of the date at which the invention was made.

#### Resolving Level of Ordinary Skill

The office action's case is also incomplete because it does not resolve the level of ordinary skill in the pertinent art" as specifically required by the Supreme Court.<sup>35</sup> "Any obviousness rejection should include... an indication of the level of ordinary skill."<sup>36</sup>

The Supreme Court has emphasized that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."<sup>37</sup> The Court required that analysis supporting a section 103 rejection should be made explicit.<sup>38</sup> Moreover, this analysis was made equally applicable to the courts and patent examiners.<sup>39</sup>

#### Conclusion

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34 148 USPQ at 467.

35 KSR Int'l Co. v. Teleflex, 127 S.Ct. 1727, 1734 (2007).

36 Examination Guidelines for Determining Obviousness Under 35 USC 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., Federal Register Vol. 72, No. 195, Page 57528.

37 Id. at 1741.

38 Id.

39 Id. at 1734.

In conclusion, the *prima facie* obviousness case is incomplete because the office action does not provide a sufficient reason as to why one of ordinary skill would have made the proposed combination of references.

#### Reasonable Expectation of Success

In addition to the reasons stated above, the *prima facie* obviousness case is also incomplete because the office action did not show that there would be a reasonable expectation of success in modifying/combining references.<sup>40</sup> Critically, to establish a *prima facie* case of obviousness, there *must* be a reasonable expectation of success.<sup>41</sup>

Furthermore, an ordinarily skilled artisan would *not* enjoy reasonable prospects of success in combining Ehrlich with Edlund. As explained above in detail, Ehrlich and Edlund employ completely inconsistent approaches. Accordingly, since an ordinarily skilled artisan would not realize reasonable prospects of success in combining Ehrlich and Edlund, a *prima facie* case of obviousness is lacking.

#### Conclusion as to Claims 1-5, 7-12, 14-19, 21-26, 28-32

As shown above, then, these claims are patentable since a *prima facie* case of obviousness does not exist. Namely, (1) the applied art fails to teach the features of the claims, (2) there is no reason to combine references as proposed by the office action, and (3) there is no showing that an ordinarily skilled artisan would have a reasonable expectation of success in making the office action's proposed modification of references.

#### 35 USC 103 REJECTIONS: CLAIMS 6 & 20

These claims were rejected under 35 USC 103 as being unpatentable over the combination of Ehrlich, Bowen, Edlund, and U.S. Patent Document 2003/0133076 ("Lehmeier").

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40 MPEP 2142, 2143.02.

41 MPEP 2143.

Even without considering the individual merits of claims 6/20, they are patentably distinguished over the proposed combination because they depend from independent claims 1/15, which are allowable over Ehrlich-Bowen-Edlund (as discussed above), and Lehmeier fails to provide the features missing from Ehrlich-Bowen-Edlund. For instance, Lehmeier still does not show the claimed combination including features such as "the browser receiving..." or "the browser providing..." or "responsive to the browser receiving..." or "the browser displaying..." Indeed, the office action's reason for introducing Lehmeier was an attempt to show a different feature, namely a search cart in the form of a pull down or a side bar. [Office Action: page 12]

Accordingly, claims 6 and 20 are patentably distinguished from the applied art.

#### 35 USC 103 REJECTIONS: CLAIMS 13 & 27

These claims were rejected under 35 USC 103 as being unpatentable over the combination of Ehrlich, Bowen, Edlund, and U.S. Patent No. 6,339,773 ("Rishe").

Even without considering the individual merits of claims 13/27, they are patentably distinguished over the proposed combination because they depend from independent claims 1/15, which are allowable over Ehrlich-Bowen-Edlund (as discussed above), and Rishe fails to provide the features missing from Ehrlich-Bowen-Edlund. For instance, Rishe still does not show the claimed combination including features such as "the browser receiving..." or "the browser providing..." or "responsive to the browser receiving..." or "the browser displaying..." Indeed, the office action's reason for introducing Rishe was an attempt to show a different feature, namely, "responsive to receiving user designation of selected entries within said search cart list, transferring said selected entries to a nonvolatile bookmarks list..." [Office Action: page 13]

Accordingly, claims 13 and 27 are patentably distinguished from the applied art.

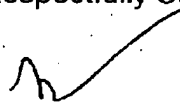
CONCLUSION

In view of the foregoing, all pending claims in the application are patentable over the applied art. Applicant requests favorable reconsideration and allowance of all pending claims for the reasons stated below.

FEES

Applicant does not believe that filing of this Amendment will incur additional fees. However, the Commissioner is authorized to charge any fees due to the Glenn Patent Group Deposit Account No. 07-1445, Customer No. 22862.

Respectfully Submitted,



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